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19 JAN 2006

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In re Application of GOGIA et al	:	
U.S. Application No.: 10/510,468	:	
PCT Application No.: PCT/IB03/01361	:	
Int. Filing Date: 11 April 2003	:	DECISION
Priority Date Claimed: 11 April 2002	:	
Attorney Docket No.: RLL-255US	:	
For: CONTROLLED RELEASE	:	
PHARMACEUTICAL COMPOSITIONS . . .	:	

This is in response to applicant's "Petition to File When Inventor Cannot Be Reached Under 37 CFR § 1.47" filed 07 November 2005.

BACKGROUND

On 11 April 2003, applicant filed international application PCT/IB03/01361, which claimed priority of an earlier India application filed 11 April 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 16 October 2003. The thirty-month period for paying the basic national fee in the United States expired on 11 October 2004.

On 07 October 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 06 April 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 November 2005, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee will be charged to Deposit Account No. 50-0912 as authorized in the petition.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that all of the joint inventors cannot be reached. However, petitioner has not provided an affidavit which describes the purported attempts to locate the inventors. Such an affidavit must be signed by the person with firsthand knowledge of the facts cited therein. Furthermore, copies of documentary evidence of attempts to locate the inventors have not been furnished.

With regard to item (3) above, the petition states the last known addresses of the nonsigning inventors.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors has not been provided. Applicant is advised that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case,

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to

the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, proof of sufficient proprietary interest in the application has not been provided.

With regard to item (6) above, no showing regarding the preservation of rights of the parties or the prevention of irreparable damage has been provided.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.36(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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